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09/741,571	12/19/2000	Kathryn L. Parker	MS #155647.1/40062.88-US-	5903
7590 Homer L. Knearl Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0903			EXAMINER PATEL, HARESH N	
			ART UNIT 2154	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/741,571

Applicant(s)

PARKER ET AL.

Examiner

Haresh Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-18,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) 19-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-18,26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 6-18, 26 and 27 are subject to examination. Claims 1-5 are cancelled. Claims 19-25 are withdrawn.

#### *Response to Arguments*

2. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

3. Regarding the applicant's statements, "The Treyz patent relates to a handheld computing device which primarily provides shopping assistance services. The shopping assistance services contemplated by Treyz include: providing directory information for a mall, handling shopping lists, displaying promotional material in relation to the shopping lists, obtaining information on merchandise in a store, and providing for wireless purchasing of products. In one embodiment of the invention, the user may adjust alert and retention time settings corresponding to various types of messages, i.e., reminders, notifications, advertisements, proximity messages, local messages, and e-mail. Treyz, col. 44; Fig. 69".

For clarification, first, the Treyz patent teachings are not limited to as per the applicant's conveniently concluded and/or presented above statements. Second, the rejections are based on MPEP laws, rules and regulations. Page 19, lines 16 – 21 of the specification of this application under prosecution, clearly states, "Although the invention has been described in language specific to structural features and/or methodological steps, it is to be understood that the invention defined in the appended claims is not necessarily limited to the specific features or steps described. Rather, the specific features and steps are disclosed as preferred forms of

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implementing the claimed invention. Since many embodiments of the invention can be made without departing from the spirit and scope of the invention, the invention resides in the claims hereinafter appended”.

The applicant has failed to consider what is claimed in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The First inquiry must be into exactly what the claims define. See *In re Wilder*, 166 USPQ 545, 548 (CCPA 1970). The applicant needs to realize that the claimed invention is in fact for a small computer device (please see the claims) which similar to the handheld computing device of the Treyz reference.

Even though the applicant insists, the claimed invention fails to provide anything that the computing device cannot be used for shopping assistance services, etc services that the Treyz device can provide.

The claimed invention fails to provide how it is different than the well-known devices including the Treyz device that can be used for wireless communication.

The claimed invention fails to provide how it is different than the many embodiments of the Treyz invention including usage of reminders, notifications, advertisements, proximity messages, local messages, e-mail, etc.

In fact, the claimed invention fails to provide the purpose of the usage of event, profile, etc., of the small computer device.

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4. Regarding the applicant's statements for the claimed limitations of the claims 6 and 9, i.e., "With respect to claim 6, Treyz fails to teach "storing two or more notification profiles for each of one or more users, wherein each notification profile is associated with a predetermined notification mode and wherein within each notification profile are notification events and wherein each of the notification events is associated with at least one notification type;" "receiving a selection signal to select one notification mode;" and "applying the selected notification mode to the small computer device and wherein the device remains in the selected notification mode until another notification mode is selected and wherein the user is notified of events in accordance with the notification profile associated with the selected notification mode." Similarly, with respect to claim 9, Treyz fails to teach any of the claim elements, such as "a memory unit storing a plurality of notification profiles for each of one or more users, wherein each notification profile is associated with a predetermined notification mode and wherein within each notification profile are notification events and wherein each of the notification events is associated with at least one notification type;" or "a processing unit in response to a profile selected from the plurality of profiles in the memory unit .... " Further, Treyz teaches neither "a first output device notifying the user of a notification event using a first notification type;" nor "a second output device notifying the user of the notification event using a second notification type, wherein the second notification type is different from the first notification type." See Treyz, Fig. 69 (providing for a single notification type, i.e., alert response, for each notification event, i.e., message)". The examiner respectfully disagrees with the applicant's arguments. First, the rejections are based on MPEP laws, rules and regulations. The applicant has failed to consider what is claimed. Although the claims are interpreted in light of the specification, limitations from

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the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The First inquiry must be into exactly what the claims define. See *In re Wilder*, 166 USPQ 545, 548 (CCPA 1970). The applicant needs to realize the usage of “for” and “wherein”, etc., for example, regarding the applicant’s usage of “wherein” and/or “whereby” and/or “adapted to” and/or “adapted for” in the claimed subject matter of the claims, the claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. Please see *Minton v. Nat’l Ass’n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003). MPEP 2111. The applicant to conveniently choose irrelevant portions of the cited reference teachings does not support overcoming the rejections. The applicant needs to refer to the presented claims for example, what is considered as notification profile, notification mode, etc., in fact the claims 6 and 9 which the applicant is arguing does not even define these entities. In fact, page 19, lines 16 – 21 of the specification of this application, clearly states, regarding the argued limitations, “Although the invention has been described in language specific to structural features and/or methodological steps, it is to be understood that the invention defined in the appended claims is not necessarily limited to the specific features or steps described. Rather, the specific features and steps are disclosed as preferred forms of implementing the claimed invention. Since many embodiments of the invention can be made without departing from the spirit and scope of the invention, the invention resides in the claims hereinafter appended”. Since, applicant's claims contain broadly claimed subject matter, it clearly reads upon the examiner's interpretation of the claimed subject matter (please see the below rejections for the limitations). Therefore, the rejection is maintained.

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5. Regarding the applicant's concern that the limitations rejected under "Official Notice" are not well-known in the art, the examiner has provided more than one references for the limitations. Therefore, the rejection is maintained.

### *Drawings*

6. New corrected drawings are required in this application because the figures do not show the claimed invention, i.e., a first output device notifying the user of a notification event using a first notification type; a second output device notifying the user of the notification event using a second notification type wherein the second notification type is different from the first notification type; and a processing unit in response to a profile selected from the plurality of profiles in the memory unit automatically determining whether to notify the user using the first notification type or the second notification type, applying the selected notification mode to the small computer device and wherein the device remains in the selected notification mode until another notification mode is selected and wherein the user is notified of events in accordance with the notification profile associated with the selected notification mode". Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled --Replacement Sheet-- in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept

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the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 6-18, 26 and 27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim 6 and its dependent claims are software per se that is not tangibly embodied on a computer storage medium and therefore lacks a practical application because it alone cannot produce its intended outcome. The specification of this application states, "The computer program product may also be a propagated signal on a carrier". Also, claim 6 and its dependent claims claim a computer program product, however the body of the claims contain process steps. Claim 6 and their dependent claims do not produce a concrete and tangible result. Storing, receiving and applying alone is not producing a tangible result. It's not until the result of the Storing, receiving, applying is provided to the user that it becomes a tangible result, which enables any usefulness of having done the storing, receiving and applying to be realized (please see the claimed subject matter of claims). Claim 9 and their dependent claims do not produce a concrete and tangible result. Determining whether to notify the user using the notification types alone is not producing a tangible result. It's not until the result of the determining is provided to the user that it becomes a tangible result, which enables any



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usefulness of having done the determining to be realized (please see the claimed subject matter of claims).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 9 and its dependent claims are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification of this application under examination in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 9 states, “a processing unit in response to a profile selected from the plurality of profiles in the memory unit automatically determining whether to notify the user using the first notification type or the second notification type”, (**usage of only one and only one notification type due to determining**)

**Which is contrary to**, the claim 9 stating, “a first output device notifying the user of a notification event using a first notification type; a second output device notifying the user of the notification event using a second notification type wherein the second notification type is different from the first notification type” (**usage of both the notification types for a single notification event**).

Also, it is not possible to first notify both the notification event using both the notification types and then determining whether to use the first notification type or the second notification type.

Claim 6 and its dependent claims are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Steps involving notifying a user of the small computer device of notification events is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Without having steps involving notifying a user of the small computer device of notification events, it is not possible to have a process that can notify a user of the small computer device of notification events. Merely steps, i.e., storing profiles, receiving a signal and applying the selected notification mode cannot support notifying the user of the small computer device of notification events.

Claim 6 and its dependent claims are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Step that select the notification mode to support applying the selected notification mode is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Without having step involving selection of the notification mode it is not possible to apply anything on the selected notification mode.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Steps interrelating among, “receiving an indication to select a notification mode”, “receiving a selection signal to select one notification mode”, “displaying a notification mode menu” is critical or essential to the practice of the invention, but not included in the

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claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The specification of this application does not provide implementing steps of the process i.e., “receiving an indication to select a notification mode”, “receiving a selection signal to select one notification mode”, “displaying a notification mode menu”, without having depend upon each other.

Claim 9 and its dependent claims are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Usage of stored profiles by the first output device, and second output device is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Without having usage of the stored profiles by the first output device, and second output device it is not possible to have the first output device, and the second output device to notify by themselves. The first output device cannot do anything by itself (referring to a first output device notifying the user of a notification event using a first notification type), and Similar applies to the second output device.

Claim 9 and its dependent claims are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The usage of the result of processing unit determining by the first output device and second output device is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Without having the usage of the result of processing unit determining by the first output device and second output device it is not possible to have the first output device, and the second output device to notify by themselves. The first output device cannot do anything by itself (referring to a first output device notifying

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the user of a notification event using a first notification type), and Similar applies to the second output device.

Claim 9 and its dependent claims are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Handling of multiple notifications that are notified to a user is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Without having multiple notifications that are notified to the user it is not possible to accomplish “notifying a user of notification events”. (Both first output device and second output device refer to the same notification event (single) for notifying).

Claims 15-18 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Limitations that interrelate between the claimed limitations of claim 9 with the claimed limitations of claims 15-18 is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Without having limitations that interrelate between the claimed limitations of claim 9 with the claimed limitations of claims 15-18, it is not possible to utilize the limitations of the claims 15-18. The limitations of the claims 15-18 cannot support the user of claim 9 to notify the notification events. For example, claim 15 contain another user and another profile, which has nothing to do with the user of claim 9 to notify the notification events.

Claims 26 and 27 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Limitations that interrelate between the claimed limitations of claim 6 with the claimed limitations of claims 26 and 27 is critical or essential to the practice of

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the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Without having limitations that interrelate between the claimed limitations of claim 6 with the claimed limitations of claims 26 and 27, it is not possible to utilize the limitations of the claims 26 and 27. The limitations of the claims 26 and 27 cannot support the user of claim 9 to notify the notification events. For example, claim 26 contain another selecting a particular notification mode, storing modified profile, which has nothing to do with the profiles used by the user of claim 9 to notify the notification events.

Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Limitations that contain and provide volume levels is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Without having limitations that contain and provide volume levels, it is not possible to select the volume levels. The “volume levels” cannot exist by it self. For example, volume levels of the computer device, or volume levels in the user profiles. Further the specification of this application mention about reducing or increasing or muting the volume levels.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Following claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 6 and its dependent claims are claiming a computer program product, however the body of the claims contain process steps.

Claim 6 and its dependent claims recite the limitations, “the selected notification mode”. There is insufficient antecedent basis for this limitation in the claim (Please see MPEP 706.03(d)). Note: receiving a selection signal is not selecting the mode.

Claim 10 recites the limitations, “the reception of email”. There is insufficient antecedent basis for this limitation in the claim (Please see MPEP 706.03(d)).

Claim 10 recites the limitations, “the notification event”. There is insufficient antecedent basis for this limitation in the claim (Please see MPEP 706.03(d)). Since, multiple “notification event” exists in the claim, it is not clear which “notification event” is referred by the limitations in the claim.

Claims 8 and 11 recite the limitations, “calendar-type application program”. These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d). The specification of this application fails to define what is considered as calendar-type application program and not calendar-type application program.

Claim 8 recites the limitations, “the selection signal for selecting one (without “the” or “said”) notification mode”. These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d).

Claim 8 recites the limitations, “program storing reminder events”. These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim

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as per MPEP rules and guidelines, MPEP 706.03(d). Claim 8 is claiming a computer program product, however storing is a step and not even mentioned to be part of the process steps of the claim 6 which the claim 8 depends to.

Claim 8 recites the limitations, "the computer further comprises". These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d). Since, multiple computer exists in the claim (claim 6 which the claim 8 depends to), it is not clear which computer is referred to.

Claim 9 recites the limitations, "the second notification type is different from the first notification type". These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d). Claim 9 fails to provide what is considered different and what is not considered different. The term "different" in claim 9 is a relative term, which renders the claim indefinite. In fact, the claim 13 contain that both the notification types are signals. Both the notification types being signal is indeed "similarity", which is contrary to the "different".

Claim 15 recites the limitations, "a user's present environment". These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d). The term "present" in claim 9 is a relative term, which renders the claim indefinite. It is not apparent what environment is considered present versus not present.

Claim 16 recites the limitations, "currently". These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d). The term "currently" in claim 9 is a relative term, which

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renders the claim indefinite. It is not apparent what profile is considered currently selected versus not currently selected.

Claim 16 recites the limitations, "a user is capable of". These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d). Also, it is not apparent what other user (without "the" or "said") has to do with the user presented in the claim 9.

Claim 26 recites the limitations, "that". These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d).

Claim 26 recites the limitations, "the modified profile". There is insufficient antecedent basis for this limitation in the claim (Please see MPEP 706.03(d)). There is not "modifying step" that indeed modified a notification profile, rather only selection is done).

Claim 27 recites the limitations, "different notification types". These limitations are indefinite for failing to particularly point out and distinctly claim the subject matter in the claim as per MPEP rules and guidelines, MPEP 706.03(d). Claim 27 fails to provide what is considered different and what is not considered different. The term "different" in claim 27 is a relative term, which renders the claim indefinite. In fact, the claim 13 contain that both the notification types are signals. Both the notification types being signal is indeed "similarity", which is contrary to the "different".

Note: Examiner has made an earnest effort to locate the limitations from the claims that are indefinite for failing to particularly point out and distinctly claim the subject matter. The



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applicant is requested to fix similar limitations, which the examiner might have overlooked, from the claims including other groups of claims.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 6-13, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz in view of "Official Notice".

Note: regarding the usage of "for" and "wherein", etc., (please see claims) for example, regarding the applicant's usage of "wherein" and/or "whereby" and/or "adapted to" and/or "adapted for" in the claimed subject matter of the claims, the claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. Please see *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003). MPEP 2111.

12. As per claims 6 and 9, Treyz teaches the following:

a computer program product readable by a computer and encoding instructions for executing a computer process for notifying a user of a small computer device of notification events (e.g., a handheld computing device notifications, figure 69), the process comprising,

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a computer system for notifying a user of notification events (e.g., a handheld computing device notifications, figure 69), the system comprising:

storing two or more profiles (e.g., each message type (fig. 69) denotes different profiles that a user can adjust to receive notification of events, i.e., proximity, local, notifications, etc, col., 35, line 53 – col., 36, line 10, col., 44, lines 20-65), of notification events for a user (e.g., multiple accounts of a user supported by handheld computing device, col., 26, lines 29-33) in the memory of the small computer device wherein the notification events are associated with at least one notification type and notifying a user of an event according to the stored profile (e.g., multiple users may be supported by handheld computing device, col., 26, lines 29-33, hence, each user may access a different shopping list and set different notification settings. As disclosed in figure 69 each user after login (each of his/her accounts) on selects and applies a particular notification mode in order to receive a notification of an event. Each message type (fig. 69) denotes different profiles that a user can adjust to receive notification of events, i.e., proximity, local, notifications, etc, col., 35, line 53 – col., 36, line 10, col., 44, lines 20-65),

at least one profile of notification events (e.g., the user can select message types, like, proximity, local, notifications, reminders, e-mail, etc. The message types are different types of events. The alert response for each message type, like, vibration, visual only, tone, etc are the different types of notifications, which user can select for each event figure 69 and 70, col. 35, line 53 – col. 36, line 10, col. 44, lines 20 – 65), wherein the notification events are associated with at least one notification type (e.g., the user can select message types, like, proximity, local, notifications, reminders, e-mail, etc. The message types are different types of events. The alert response for each message type, like, vibration, visual only, tone, etc are the different types of

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notifications, which user can select for each event figure 69 and 70, col. 35, line 53 – col. 36, line 10, col. 44, lines 20 – 65),

associating profile with a unique notification mode (e.g., the relationship between the message types (notification event) and the alert response (notification type) for each message type, like, vibration, visual only, tone, etc., figure 69 and 70, col. 35, line 53 – col. 36, line 10, col. 44, lines 20 – 65),

receiving a selection signal to select one notification mode (e.g., graphical user interface prompts to the user, col. 35, line 53 – col. 36, line 10, col. 44, lines 20 – 65),

applying the selected notification mode to the small computer device wherein the device remains in the selected notification mode until another notification mode is selected and wherein the user is notified of events in accordance with the profile associated with the selected notification mode, notifying a user of an event according to the stored profile (e.g., user can store his personnel settings (hence notification mode saved until personnel settings are altered for another selection for the notification type) for the messages events with the notification types and to select the events versus notification types, which can be saved locally or at a remote server and which user can modify whenever he desires to do so, figure 69 and 70, col. 35, line 53 – col. 36, line 10, col. 44, lines 20 – 65),

a memory unit for storing a plurality of profiles for a user (e.g., storage for multiple profiles and support for multiple users, multiple accounts available to each user, figure 4, col., 35, line 53 – col., 36, line 10, col., 44, lines 20-65), the profile relating notification events with notification types (e.g., user can store his personnel settings for the messages events with the notification types and to select the events versus notification types, which can be saved locally or

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at a remote server and which user can modify whenever he desires to do so, figure 69 and 70, col. 35, line 53 – col. 36, line 10, col. 44, lines 20 – 65),

a first output device for notifying the user of a notification event using a first notification type (e.g., speaker to provide audible alert to the user, col. 35, lines 53-64),

a second output device for notifying the user of the notification event using a second notification type wherein the second notification type is different from the first notification type (e.g., vibration unit 116 may be used to vibrate handheld computing unit when it is desired to alert the user by vibrations without disturbing people in the vicinity of handheld computing unit by not using an audible alert, col. 15, line 64 – col.16, line 15);

a processing unit in response to a profile selected from the plurality of profiles in the memory unit automatically determining whether to notify the user using the first notification type or the second notification type ( processor, figure 4, audio tones or vibration unit, col. 15, line 64 – col.16, line 15).

However, Treyz do not specifically mention about notification profiles and each notification profile (note: without “said” or “the” not necessarily the same profile mentioned earlier) is associated with a predetermined notification mode and wherein within each notification profile (note: without “said” or “the” not necessarily the same profile mentioned earlier) are notification events and each of the notification events is associated with a notification type.

“Official Notice” is taken that both the concept and advantages of providing notification profiles and each notification profile is associated with a predetermined notification mode and wherein within each notification profile are notification events and each of the notification

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events is associated with a notification type(s) is well known and expected in the art. For example, Hunter et al., 6,850,901 discloses these limitations, col., 11, line 13 - col., 13, line 53. Shteyn et al., 6,782, 253 discloses these limitations, col., 3, line 1 – col., 4, line 45. Chen et al., 2002/0177453, paragraphs 100-102.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include notification profiles and each notification profile is associated with a predetermined notification mode and wherein within each notification profile are notification events and each of the notification events is associated with a notification type(s) with the teachings of Treyz in order to facilitate usage of the notification profile and predetermined notification mode because the notification profile would support retaining information related to a user specific information. Having multiple notification profiles would support retaining specific information for multiple users respectively. The predetermined notification mode would provide help specify which type of the notification mode the profile is related to. The notification events that are related to notification type(s) would provide information on what notification type(s) is used for the notification events of the profile.

13. As per claims 7, 8, 10-13, Treyz and “Official Notice” disclose the claimed limitations as rejected above. Treyz also teaches the following:

a calendar-type application program storing reminder events and wherein the selection signal is generated by the calendar-type application program, the notification event is a calendar event stored by a calendar-type application program (e.g., calendar of events at a bookstore, if the user is interested in the event, the user may select set reminder option, col. 35, lines 53-64),

the notification event is the reception of email over a wireless network, (e.g., the handheld computing device may also be used for communications functions such as sending and receiving e-mail. Wireless communications may involve short-range or local wireless links and may also involve longer-range or remote wireless links (col. 2, lines 11-15),

applying the selected notification mode to the small computer device and wherein the device remains in the selected mode until another mode is selected and wherein the user is notified of events according to the selected notification mode (e.g., the user can select and set notification events. The user settings are retained using the handheld device for each user. The user is also allowed to select and set notification types for the notification events. Also the user is allowed to select or modify or retain the notification type for each notification event, in the manner the user desires to do so (e.g., figure 69 and 70, col. 35, line 53 – col. 36, line 10, col. 44, lines 20 – 65),

associating profile with a unique notification mode (e.g., the user can select and set notification events. The user settings are retained using the handheld device for each user. The user is also allowed to select and set notification types for the notification events. Also the user is allowed to select or modify or retain the notification type for each notification event, in the manner the user desires to do so (e.g., figure 69 and 70, col. 35, line 53 – col. 36, line 10, col. 44, lines 20 – 65),

receiving a selection signal to select one notification mode (e.g., graphical user interface provided by the handheld device to the user for notification mode selections, col. 35, lines 53-64),

the first notification type is an audible signal and the second notification type is a visual display, the first notification type is a vibration signal and the second notification type is an audible signal (e.g., audio tones or vibration unit etc. with different output notification types, col. 15, line 64 – col.16, line 15).

14. As per claims 26 and 27, Treyz does not specifically mention about the further claimed limitations of claims 26 and 27.

“Official Notice” is taken that both the concept and advantages of providing selecting a particular notification mode (note: not related to the notification mode claimed earlier in the claim) to modify a notification profile (note: not related to the notification profile claimed earlier in the claim) for that mode, storing the modified profile, selecting volume levels for different notification types (note: not related to the notification type claimed earlier in the claim) associated with notification events (note: not related to the notification events claimed earlier in the claim) within a notification profile (note: not related to the notification profile claimed earlier in the claim) is well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include selecting a particular notification mode to modify a notification profile for that mode, storing the modified profile, selecting volume levels for different notification types associated with notification events within a notification profile with the teachings of Treyz in order to facilitate usage of selecting the particular notification mode, storing the modified profile, selecting volume levels because the profile would support retaining information related to a user specific information. Having multiple notification profiles would support retaining specific

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information for multiple users respectively. The particular notification mode would provide help specify which type of the notification mode the profile is related to. The modified profile with modified information would be available for future use. The selection of volume levels would help specify the volume levels for the notification types. The notification events that are related to notification type(s) would provide information on what notification type(s) is used for the notification events of the profile.

15. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz and “Official Notice” in view of Wies et. al, 6,125,385 (Hereafter Wies).

16. As per claim 14, Treyz and “Official Notice” disclose the claimed limitations as rejected above. Treyz also teaches the concept of accessing the settings that are stored in the profile, for example, to assign/select a tone for a notification event (e.g., figure 69, col., 35, line 53 – col., 36, line 10, col., 44, lines 20-65).

However, Treyz does not specifically mention about assignment of a particular sound file to a particular event.

Wies discloses assignment of a particular sound file to a particular event (e.g., col., 7, lines 2-3, col., 32, line 48 – col., 33, line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Treyz and “Official Notice” with the teachings of Wies in order to facilitate assigning a particular sound file to a particular event because a sound file would be used to help provide an audio alert assigned to an event. A profile containing information related to a user including sound file selection will help the user to select different



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sound files for different events. The selection of a sound file for an event would help store the sound file for a user.

17. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz and "Official Notice" in view of Zimmers et al., 6,816,878 (Hereinafter Zimmers).

18. As per claim 15, Treyz and "Official Notice" disclose the claimed limitations as rejected above. However, Treyz does not specifically mention about an event notification type based on a user's present environment.

Zimmers discloses the concept to module an event notification type based on a user's present environment (e.g., col., 7, lines 5 - 58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Treyz and the "Official Notice" with the teachings of Zimmers in order to facilitate an event notification type based on a user's present environment because the notification type and the environment would help provide different notifications based on the event type. The user's present environment would help provide notification for the user. The notification with type would help the user to know about the notification event.

19. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz, "Official Notice" in view of Shetty et al., 5,808,907 (Hereinafer Shetty).

20. As per claims 16-18, Treyz and "Official Notice" disclose the claimed limitations as rejected above. However, Treyz does not specifically mention about a user is capable of being

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notified of an event in a plurality of ways, depending on a currently selected profile, each of a plurality of profiles contains the plurality of notifications for an event.

Shetty discloses the concept of a user notified of an event in a plurality of ways (e.g., col., 2, lines 38 - 61), depending on a currently selected profile (e.g., col., 2, lines 38 - 61), each of a plurality of profiles contains the plurality of notifications for an event (e.g., col., 2, lines 38 - 61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Treyz and "Official Notice" with the teachings of Shetty in order to facilitate a user notified of an event in a plurality of ways, depending on a currently selected profile, each of a plurality of profiles contains the plurality of notifications for an event because the event would help notify the user. The plurality of ways would help event provided to the user. The currently selected profile would help the software know which way the event needs to be provided to the user. Having a plurality of profiles would help the user to support multiple events. The plurality of notifications for an event would help the event notified to the user using different notifications.

### *Conclusion*

21. The prior art made of record (forms PTO-892 and applicant provided IDS cited arts) and not relied upon is considered pertinent to applicant's disclosure.

Examiner has cited particular columns and line numbers and/or paragraphs and/or sections and/or page numbers in the reference(s) as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing

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responses, to fully consider the references in entirety, as potentially teaching, all or part of the claimed invention, as well as the context of the passage, as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Haresh Patel

December 28, 2006